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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,161	11/04/2003	Stephen Michael Campbell	KC-20,043	5526

7590 06/22/2005
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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,161

Applicant(s)

CAMPBELL ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0118, 0209.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. The restrictions are considered moot in view of the cancellation of non-elected claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 9-25, 32, 33, and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhou (US 2002/0124956). Zhou teaches a bonded structure comprising a first substrate, a second substrate and an adhesive composition bonding the first substrate and the second substrate to one another at an add-on level within the claimed range (table 1). The bonded structure has a dynamic peel strength within the claimed range (tables 1-4). The adhesive composition comprises 80% by weight of atactic poly-alpha-olefin (APAO), 50 to 65% by weight of tackifier and antioxidant stabilizer [0008],[0083]. The APAO comprises a polypropylene-1-butene [0028, claim 14]. Since Zhou and Applicants use the hot melt composition in the same applications such as disposable

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diapers, hospital pads and surgical drapes, it is not seen that the substrate could not have been one of the materials as recited by the claims so as to sufficiently perform the same functions. The same token is applied to the thickness of the substrate. Further, Zhou does not teach the bonded structure having no burn through visual defects and the Brookfield viscosity of about 1000 to 1500 centipoise at 190°C. However, it appears that the bonded structure of Zhou meets all the structural limitations as required by the claims. The bonded structure comprises the first and second substrates and an adhesive bonded the two substrates to one another. The adhesive is made of a composition as recited by the claims. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. Like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. With regard to claim 4, it appears that nothing in Applicants' specification discloses or suggests the inclusion of crystalline polypropylene in the adhesive composition affects the novel or basic characteristics of Applicants' invention. Therefore, Applicant bears the burden in establishing that non-recited components materially change the characteristics of Applicants' invention (MPEP 2112; *In re Delajarte* 143 USPQ 256) in order to overcome the issue of anticipation. Accordingly, the language "consisting essentially of" is treated as "comprising" until Applicants provide the evidence in establishing that non-

recited components materially change the characteristics of Applicants' invention. Accordingly, it is the examiner's position that Zhou anticipates the claimed subject matter.

4. Claims 1-25 and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al (US 2003/0096896). Wang teaches a bonded structure comprising a first substrate, a second substrate and an adhesive composition bonding the first substrate and the second substrate to one another at an add-on level within the claimed range (examples 1-3). The bonded structure has a dynamic peel strength within the claimed range (examples 4-8). The adhesive composition comprises 15%-80% by weight of the blend of syndiotactic polypropylene (SPP) and atactic poly-alpha-olefin (APAO) wherein the blend has a ratio of 20% SPP and 80% APAO. Likewise, the adhesive composition contains 12% to 64% by weight of APAO within the claimed range. The adhesive composition comprises 15%-80% by weight of the blend of syndiotactic polypropylene (SPP) and atactic poly-alpha-olefin (APAO) wherein the blend has a ratio of 10% SPP and 90% APAO. Likewise, the adhesive composition contains 13.5% to 72% by weight of APAO within the claimed range. The adhesive composition contains a C5 hydrocarbon tackier with an amount within the claimed range (table 2). The adhesive composition contains an antioxidant stabilizer (table 2). The APAO comprises a polypropylene-1-butene [0091]. Since Wang and Applicants use the hot melt composition in the same applications such as disposable diapers, hospital pads and

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surgical drapes, it is not seen that the substrate could not have been one of the materials as recited by the claims so as to sufficiently perform the same functions. The same token is applied to the thickness of the substrate. Further, Wang does not teach the bonded structure having no burn through visual defects and the Brookfield viscosity of about 1000 to 1500 centipoise at 190oC. However, it appears that the bonded structure of Wang meets all the structural limitations as required by the claims. The bonded structure comprises the first and second substrates and an adhesive bonded the two substrates to one another. The adhesive is made of a composition as recited by the claims. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. Like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. With regard to claim 4, it appears that nothing in Applicants' specification discloses or suggests the inclusion of SPP in the adhesive composition affects the novel or basic characteristics of Applicants' invention. Therefore, Applicant bears the burden in establishing that non-recited components materially change the characteristics of Applicants' invention (MPEP 2112; *In re Delajarte* 143 USPQ 256) in order to overcome the issue of anticipation. Accordingly, the language "consisting essentially of" is treated as "comprising" until Applicants provide the evidence in establishing that non-recited components materially change

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the characteristics of Applicants' invention. Accordingly, it is the examiner's position that Wang anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhou (US 2002/0124956) as applied to claim 1 above, and further in view of Wang et al (US 2003/0096896). Zhou does not specifically disclose the tackifier comprising a C5 hydrocarbon tackifier. Wang, however, teaches a hot-melt composition comprising a C5 hydrocarbon tackier which has a molecular weight of about 2000 Daltons or less. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a C5 hydrocarbon tackifier in the adhesive composition in view of compatibility with APAO.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-25, and 32-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,657,009 in view of Wang et al (US 2003,0096896). Claims 1-15 of U.S. Patent No. 6,657,009 teach a hot-melt adhesive composition comprising 70% to 90% polypropylene-1-butene amorphous poly-alpha-olefin. Claims 1-15 of U.S. Patent No. 6,657,009 do not teach the adhesive composition comprising a tackifier. Wang, however, teaches the adhesive composition comprising 15% to 65% by weight of the tackifier. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use tackifier in the adhesive composition motivated by the desire to increase the tackiness of the adhesive. Claims 1-15 of U.S. Patent No. 6,657,009 do not teach the bonded structure comprising a first substrate and second substrate. Wang, however, teaches the use of the adhesive composition in disposable diapers to join the first substrate to the second substrate. Wang also teaches the use of the amount of the adhesive within the claimed range. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use

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the adhesive composition in disposable diapers to bond the first substrate to the second substrate because such is intended use of the adhesive composition and Wang provides necessary details to practice the invention of the U.S. Patent No. 6,657,009.

The combined teachings of the U.S. Patent No. 6,657,009 and the Wang invention arrive at the bonded structure having a structure as recited by the claims. The resulting bonded structure is comprised of a first substrate, a second substrate, an adhesive composition having the same amount and composition as the presently claimed adhesive composition. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. Like material has like property. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties.

With regard to claim 4, it appears that nothing in Applicants' specification discloses or suggests the inclusion of crystalline polypropylene in the adhesive composition affects the novel or basic characteristics of Applicants' invention. Therefore, Applicant bears the burden in establishing that non-recited components materially change the characteristics of Applicants' invention (MPEP 2112; *In re Delajarte* 143 USPQ 256). Accordingly, the language "consisting essentially of" is treated as "comprising" until Applicants provide the evidence in

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establishing that non-recited components materially change the characteristics of Applicants' invention.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo

**HAI VO
PRIMARY EXAMINER**